

Atty Dkt. No.: PAI X-002CON
USSN: 09/828 539

REMARKS

Formal Matters

Claims 33-44 and 46-53 are pending in the present application. Claim 40 is amended. Entry of the amendment for the purposes of consideration by the Examiner at her discretion or the Board of Appeals is hereby requested and believed permissible under MPEP §§1207 and 1210. At minimum, the amendment is believed properly entered for reason that it removes an issue from appeal — namely whether claim 40 embraces two differently sized set of particles as Applicant has argued and as the Examiner now deems otherwise.¹

Comment

The amendment to claim 40 is in response to a new argument posed by the Examiner refuting Applicant's position that two distinct size ranges of particles are required of the claims. The claim language clarifies that the composition claimed is not one in which only particles of a size "about" 350 μ are provided. Instead, as argued during prosecution of the application and as discussed in the specification as filed, the claim now explicitly requires a composition including larger particle radiopaque tracers added to a composition containing smaller particles for contrast. (Page 7). While the claim is believed to have already been fairly clear as to having two different size ranges of particles (one to be individually viewable, and one for contrast), the claim is now clarified remove any issue of claim interpretation regarding the same. Read as the claim is intended, claim 40 and those dependent therefrom are believed to be in condition for allowance. Thus, further supporting entry of the present amendment.

¹ Should the Examiner not enter this Amendment as believed required, Applicant reserves the right to assert the prohibition against new grounds of rejection in the Examiner's Answer per MPEP §1208.01. In which case, it is believed that the Examiner will be required to reopen prosecution and specifically consider the present amendment. However, no such treatment is believed necessary in accordance with MPEP §1207 so long as the amendment is entered and the comments applicant has provided to date regarding the use of larger particles for a tracer function and smaller particles for contrast is directly addressed or considered by the Examiner.

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Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number.

Respectfully submitted,
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